

### **REMARKS**

Claims 1 and 10 have been amended. Claims 1-16 remain pending in the above-captioned patent application.

#### **Regarding the Office Action:**

In the Office Action<sup>1</sup>, the Examiner provisionally rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending application by Nojima, et al. (U.S. Application No. 2003/0162105) ("Nojima"). Next, the Examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Nojima in view of Tanaka, et al. (U.S. Patent No. 6,567,972) ("Tanaka"). Finally, the Examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Kotani, et al. (U.S. Patent No. 6,853,743) ("Kotani") in view of Tanaka. In this Amendment, Applicants amend claims 1 and 10 to more appropriately define the invention.

#### **Regarding the Double Patenting Rejection:**

Applicant respectfully traverses the nonstatutory double patenting rejection of claims 1-16 on the grounds that the Examiner has failed to establish that the claims of this application are not patentability distinct over claims 1-14 of Nojima.

Amended claim 1 recites a "monitor portion satisfying a condition that the calculated edge moving sensitivity is lower than a predetermined lower limit value or higher than a predetermined upper limit value," and amended claim 10 recites a "monitor portion having the calculated distance which satisfies a condition that edge

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<sup>1</sup> The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

moving sensitivity is lower than a predetermined lower limit value or higher than a predetermined upper limit value, the edge moving sensitivity corresponding to a difference between a proper exposure dose and an exposure dose to be set when a pattern edge varies." On the other hand, claim 1, for example, of Nojima recites "a method of manufacturing a photomask comprising: determining dimensions of a pattern in a photomask including dimensions of critical pattern portions in which an exposure latitude is low; determining an exposure latitude on the basis of the dimensions of the mask; and judging if the photomask is defective or nondefective on the basis of whether or not the exposure latitude falls within a prescribed exposure latitude." Claims 1 and 10, and claims 2-9 and 11-16, which depend therefrom, are therefore patentably distinct over claims 1-14 of Nojima. The Examiner's double patenting rejection should be withdrawn at least for this reason.

Moreover, Applicants respectfully submit that since Nojima has not yet issued as a patent. Accordingly, the Examiner's double patenting rejection is premature, and should be withdrawn for this additional reason.

Further, pursuant to M.P.E.P. § 804:

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). ...

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Emphasis added.

Applicants respectfully note that the Examiner fails to give “reasons why a person of ordinary skill in the art would conclude that the invention defined in a claim in issue is an obvious variation of the invention defined in the patent.” M.P.E.P. § 804. Thus, the Examiner has failed to establish that the claims define an obvious variation of the invention defined in claims 1-14 of Nojima and has thus not met the burden for showing that a case of obviousness type double patenting exists. Thus, for this additional reason, Applicants respectfully request that the provisional rejection of claims 1-16 under nonstatutory double patenting be withdrawn.

**Regarding the Rejection under 35 U.S.C. § 103:**

Applicants respectfully traverse the Examiner’s rejection of claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Nojima in view of Tanaka; and the rejection of claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Kotani in view of Tanaka.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available

to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’ s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Independent claim 1, recites a combination including, for example, “determining a monitor portion of the mask pattern, based on the calculated *edge moving sensitivity*, the monitor portion satisfying a condition that the calculated edge moving sensitivity is *lower than* a predetermined lower limit value *or higher than* a predetermined upper limit value,” (emphasis added). Nojima fails to disclose at least this quoted subject matter. Specifically, although Nojima teaches a method of manufacturing a photomask, but is silent as to calculating an edge moving sensitivity as recited in claim 1. Paragraph 26. Accordingly, Nojima fails to teach each and every element of claim 1.

Tanaka discloses a photomask manufacturing apparatus which uses a method for correcting a mask pattern, col. 4, lines 12-18, and Kotani discloses a mask pattern correction method, col. 10, lines 38-40. Neither reference, however, cures the deficiencies of Nojima as described above. Therefore, the references cited by the Examiner, taken alone or together, fail to render claim 1 obvious. As such, claim 1 is allowable over the applied references and claims 2-9 are allowable at least due to their dependence from claim 1.

Although of different scope, claim 10 recites similar features as those recited in claim 1. For example, claim 10 recites a “monitor portion having the calculated distance which satisfies a condition that edge moving sensitivity is lower than a predetermined lower limit value or higher than a predetermined upper limit value, the

edge moving sensitivity corresponding to a difference between a proper exposure dose and an exposure dose to be set when a pattern edge varies." Claim 10 is therefore allowable over Nojima, Tanaka, and Kotani at least for reasons disclosed above in regard to claim 1, and claims 11-16 are allowable at least due to their dependence from claim 10.

**Conclusion:**

Applicants respectfully request reconsideration of the application and withdrawal of the above detailed rejections. Applicants submit that pending claims 1-16 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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